

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 1617
Thor)	
)	Examiner: Chong, Yong Soo
)	
Serial No.: 10/049,427)	Confirmation No.: 1087
)	
Filed: 05/06/2002)	
)	
Atty. File No.: 4220-78-PUS)	
)	Electronically Filed
For: MEHTODS OF USING)	
RAPID -ONSET SELECTIVE)	
SEROTONIN REUPTAKE)	
INHIBITORS FOR TREATING)	
SEXUAL DYSFUNCTION)	

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION UNDER 37 CFR §1.705(b)

Dear Sir:

1. This is a request for reconsideration of the patent term adjustment of 453 days indicated on the Notice of Allowance mailed April 16, 2009.
2. This application is being filed no later than the time of filing of the issue fee.
3. Applicant submits herewith a "Statement Under 37 CFR §1.702(2)".
4. In accordance with 36 CFR §1.705(b)(1), please charge the fee set forth in 37 CFR §1.18(e) (\$200) to our Deposit Account No. 19-1970. Please charge any necessary additional fees or credit any overpayments to our Deposit Account No. 19-1970.

Respectfully submitted,

SHERIDAN ROSS P.C.

By:



Eric B. Ives

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Denver, Colorado 80202-5141

(303) 863-9700

Date: 7-16-2009

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Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

STATEMENT UNDER 37 C.F.R. §1.702(b)(2)

Dear Sir:

1. This statement is respectfully submitted in support of the "Application for Patent Term Adjustment Including Request for Reconsideration Under 37 C.F.R. §1.705(b)" for the above-referenced patent. In view of the following, it is respectfully requested that Applicant be granted a patent term adjustment of **1,137** days.

2. The patent term adjustment indicated on the Notice of Allowance mailed April 16, 2009 under 35 U.S.C. §154(b) is 453 days (a copy of the relevant page of the Notice is submitted herewith as Exhibit A). This determination of 453 days is in error. The correct patent term adjustment, based on the available estimates of issuance, is **1,137** days. The relevant grounds for adjustment under 37 C.F.R. §1.702 include: (a)

"Failure to take certain actions within specified time frames", (b) "Failure to issue a patent within three years from the actual filing date of the application", and (e) "Delays caused by successful appellate review". (See *Wyeth v. Dudas*, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008)). The relevant dates and facts will be discussed below.

A. Examination Delays Pursuant to 37 C.F.R. §1.703(a)

Pursuant to 37 C.F.R. §1.703(a), Applicant is entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months after the actual filing date (i.e., by July 6, 2003) (hereinafter "14 Month Delay"). As the Office failed to mail an action under 35 U.S.C. § 132 until August 15, 2003, Applicant is entitled to a period of patent term adjustment beginning on the day after the date that is 14 months after the date on which the above-referenced application was filed under 35 U.S.C. §111(a), i.e. July 7, 2003, and ending on the date of mailing of an action under 35 U.S.C. §132, i.e., August 15, 2003. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is 40 days, which is in agreement with the period calculated by the Office on the Patent Term Adjustment History ("PTA History"). The PTA History is submitted herewith as Exhibit B. The PTA history shows the 40 day period calculated by the Office.

Also pursuant to 37 C.F.R. § 1.703(a), Applicant is entitled to a period of patent term adjustment due to failure by the Office to mail an Office Action not later than four months after Applicant submitted a response to a previous action (herein "4 Month Delay"). Applicant submitted a Response to a Non-Final Office Action on June 2, 2004. Since the Office failed to mail a subsequent Office Action until March 10, 2005, Applicant is entitled to a period of patent term adjustment beginning on the day after the date that is four months after the date on which the Response was filed, i.e., October 3, 2004, and ending on the date the Office mailed the subsequent Office Action, i.e., March 10, 2005. Therefore, the period of patent term adjustment due to

the 4 Month Delay is **159** days, which is in agreement with the period calculated by the Office (See Exhibit B).

B. "Three Years Delay" Pursuant to 37 C.F.R. §1.703(b)

In addition to the patent term adjustment due to the 14 Month Delay and the 4 Month Examination Delay, Applicants are entitled to a period of patent term adjustment pursuant to 37 C.F.R. §1.703(b). The period of delay under 37 C.F.R. §1.703(b) is equal to the number of days in the period beginning on the day after the date that is three years after the date on which the above referenced application was filed under 35 U.S.C. §111(a), i.e, May 7, 2005, and ending on the date a patent is issued, but not including the number of days, if any, in the period beginning on the date on which a request for continued examination (RCE) under 35 U.S.C. §132(b) was filed and ending on the date the patent was issued (hereinafter "Three Years Delay"). An RCE was filed on July 28, 2006, therefore, the period of Three Years Delay will be **448** days. This value was not listed in the calculations by the Office (See Exhibit B).

C. "Delays caused by successful appellate review" Pursuant to 37 C.F.R. §1.703(e)

Applicant is also entitled to a period of patent term adjustment pursuant to 37 C.F.R. §1.703(e). The period for adjustment under 37 C.F.R. §1.703(e) is "the period beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed... and ending on the date of a final decision by the Board..." A notice of appeal was filed January 1, 2007, but a favorable decision by the Board was not issued until February 5, 2009. Therefore, the period of patent term adjustment due to the appeal process is **765** days, which is in agreement with the period calculated by the Office (See Exhibit B).

As set forth in 37 C.F.R. §1.703(f), Applicant is entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 C.F.R. §1.702 (hereinafter "Office Delay") reduced by the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to

37 C.F.R. §1.704 (hereinafter "Applicant Delay"). In this petition, the sum of the period of the 14 Month Delay and the period of the 4 Month Delay under 37 C.F.R. §1.703(a) is referred to as "Examination Delay." In this petition, the period of caused by successful appellate review pursuant to 37 C.F.R. § 1.703(e) is referred to as "Appeal Delay". With respect to the above-referenced application, the total period of Office Delay is the sum of the period of the Three Years Delay (448 days) under 37 C.F.R. §1.703(b), the period of Examination Delay (199 days) under 37 C.F.R. §1.703(a), and the "Appeal Delay" (765 days) under 37 C.F.R. §1.703(e) *to the extent these periods of delay are not overlapping*. As the period of 14 Month Delay ended on July 6, 2003, prior to the first day of the period of Three Years Delay, i.e., May 7, 2005, Applicant submits that these periods are not overlapping. Patentees notes, however, that the 159 day period of 4 Month Delay (October 3, 2005 to June 10, 2005) overlaps with the Three Year Delay period (May 7, 2005 to July 28, 2006), resulting in 35 days of overlap (May 7, 2005 to June 10, 2005). The period of the Three Year Delay and the Appeal Delay do not overlap, as the Three Year Delay ends with the filing of the RCE on July 28, 2006 and the Notice of Appeal was filed January 3, 2007. Accordingly, Patentees submit that the total period of Office Delay is 1377 days, which is the sum of the period of Three Year Delay (448 days), the period of Examination Delay (199 days), and the Appeal Delay (765 days) reduced by the period of overlap (35 days).

14-month delay	40 days
4 month delay	159 days
Three year delay	448 days
Appeal delay	765 days
<u>Overlap</u>	<u>(35 days)</u>
Total Office Delay	1377 days

To calculate the period of patent term adjustment, the total period of Office Delay is reduced by the period of Applicant Delay, which the USPTO calculates as a period of 511 days (see "Applicant Delay" in Exhibit B). Applicant disputes the Applicant Delay calculated by the Office. As detailed below, Applicant concludes that that Applicant delay is only 240 days. Accordingly, Applicant submits that the correct patent term adjustment for the above-referenced application is 1,137 days which is the difference between the total period of Office Delay (1377 days) and the period of Applicant Delay (240 days) (see below).

D. "Applicant Delay" Pursuant to 37 C.F.R. §1.704

Pursuant to 37 C.F.R. §1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. The circumstances during the prosecution of the application that resulted in the above-identified patents are summarized as follows:

(i) Pursuant to 37 C.F.R. §1.704(b), the period of adjustment of the term of a patent under 37 C.F.R. § 1.703(a) through (e) is reduced by the period of time in excess of three months that is taken to reply to any notice or action by the Office. A non-final Office Action was mailed on December 1, 2003. Applicant responded to the non-final Office Action on June 2, 2004, which is three months and 91 days after the mailing date of the non-final Office Action. This constitutes a 91 day Applicant Delay under 37 C.F.R. § 1.704(b), in agreement with the Office.

(ii) A second non-final Office Action was mailed on March 10, 2005. Applicant responded to the second non-final Office Action on July 8, 2005 which is three months and 28 days after the mailing date of the second non-final Office Action. This constitutes a 28 day Applicant Delay under 37 C.F.R. § 1.704(b).

(iii) A Final Office Action was mailed on October 4, 2005. Applicant responded by filing a Notice of Appeal on April 4, 2006, which is three months and 90 days after the mailing date of the third non-final Office Action. This constitutes a 90 day Applicant Delay under 37 C.F.R. § 1.704(b).

(iv) Pursuant to 37 C.F.R. §1.704(c)(8), the period of adjustment of the term of a patent under 37 C.F.R. § 1.703(a) through (e) is reduced by the submission of a supplementary reply or paper after a reply is filed. The period of adjustment is the number of days after the initial reply was filed. An IDS was filed on Aug 28, 2006, 31 days after the filing of the RCE on July 28, 2006. This constitutes a 31 day Applicant Delay under 37 C.F.R. §1.704(c)(8).

(v) 37 C.F.R. §1.704(c)(8) states: "Submission of a supplemental reply or other paper, *other than* a supplemental reply or paper *expressly requested by the examiner*, after a reply has been filed, in which case the period of adjustment set forth in §1.703 shall be reduced...". Applicant filed a supplemental IDS on February 28, 2005 in direct response to a telephonic request from Examiner Mitchell to Applicant's representative Gary Connell on February 18, 2005. The Examiner indicated that the references filed with the previous IDS filed June 2, 2004 were not in the PTO's electronic system. The Examiner requested that Mr. Connell submit a replacement IDS. Mr. Connell filed the supplemental IDS within 10 days of the request. As the IDS of February 28, 2005 was in direct response to an express request from the Examiner, an adjustment under 37 C.F.R. §1.704(c)(8) does not apply (i.e., 0 days). This is in contrast to the listing of the Office indicating a 271 day adjustment.

(vi) Applicant notes that an amendment under §1.312 is being filed concurrently with this application. Under 37 C.F.R. §1.704(c)(10)(i) the adjustment will be the lesser of:

“(i) The number of days, if any, beginning on the date the amendment under §1.312 or other paper was filed and ending on the mailing date of the Office Action or notice in response to the amendment under §1.312 or such other paper; or

(ii) Four months...”

As Applicant has no way of predicting when the Examiner will respond to the 1.312 amendment, any adjustment under 37 C.F.R. §1.704(c)(10)(i) is not including in the calculations below.

The Total Applicant Delay is calculated as follows:

Response to First Office Action Delay	91 days
Response to Second Office Action Delay	28 days
Response to Third Office Action Delay	90 days
IDS	31 days
Total Applicant Delay	240 days

As indicated on the PTA History (Exhibit B), the Office has calculated a period of Applicant Delay of 511 days. This is in disagreement with the Applicant Delay calculated by Patentee, as explained above.

E. Calculation of Correct Patent Term Adjustment Pursuant to 37 C.F.R. § 1.702(f)

As set forth in 37 C.F.R. § 1.703(f), Applicants are entitled to a period of patent term adjustment equal to the period of PTO Delay reduced by the period of Applicant Delay. Therefore, Applicants submit that the correct patent term adjustment for the above-referenced application is **1,137days**, which is the difference between the total period of PTO Delay (1377 days) and the period of Applicant Delay (240 days).

F. No Terminal Disclaimer

In accordance with 37 C.F.R. § 1.705(b)(2)(iii), Applicant submits that the above identified application is not be subject to a terminal disclaimer.

G. Conclusion

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **1,137 days**.

Respectfully submitted,

SHERIDAN ROSS P.C.

By:



Eric B. Ives
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1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: 7-16-2009

Exhibit 1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address Correspondence to: PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO. 10/049,427	FILING DATE 05/06/2003	FIRST NAMED INVENTOR Karl Bruce Thoe	ATTORNEY DOCKET NO. X-11072	CONFIRMATION NO. 6287
390 0416/2009				
SHERIDAN ROSS, P.C. 1560 BROADWAY SUITE 1200 DENVER, CO 80202-5141				
EXAMINER CROOK, TONG BOO				
ART UNIT 1617				
DATE MAILED: 04/16/2009				

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 453 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 453 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Exhibit 2

Patent Term Adjustment			
Filing or 371(c) Date:	05-06-2002	USPTO Delay (PTO) Delay (days):	964
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	511
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	453
USPTO Adjustment (days):	+0	Explanation Of Calculations	?

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
04-16-2009	Mail Notice of Allowance		
04-11-2009	Document Verification		
04-11-2009	Notice of Allowance Data Verification Completed		
02-05-2009	Mail BPAI Decision on Appeal - Reversed	765	
02-04-2009	BPAI Decision - Examiner Reversed	↑	
02-03-2009	Mail BOA miscellaneous communication to applicant	↑	
02-03-2009	BOA miscellaneous communication to applicant	↑	
12-15-2008	Confirmation of Hearing by Appellant	↑	
12-02-2008	Notification of Appeal Hearing	↑	
04-23-2008	Docketing Notice Mailed to Appellant	↑	
04-22-2008	Assignment of Appeal Number	↑	
04-02-2008	Appeal Awaiting BPAI Docketing	↑	
11-28-2007	Mail Reply Brief Noted by Examiner	↑	
11-26-2007	Reply Brief Noted by Examiner	↑	
10-18-2007	Date Forwarded to Examiner	↑	
10-05-2007	Reply Brief Filed	↑	
10-05-2007	Request for Oral Hearing	↑	
09-27-2007	Appeal ready for BPAI docketing	↑	
09-20-2007	Mail Miscellaneous Communication to Applicant	↑	
09-13-2007	Miscellaneous Communication to Applicant - No Action Count	↑	
09-05-2007	Return of Undocketed appeal to the TC	↑	
09-05-2007	Exam. Ans. Review Complete	↑	
08-10-2007	Mail Examiner's Answer	↑	
08-06-2007	Examiner's Answer to Appeal Brief	↑	
06-27-2007	Date Forwarded to Examiner	↑	
05-25-2007	Appeal Brief Filed	↑	
04-27-2007	Notice -- Defective Appeal Brief	↑	
04-25-2007	Appeal Brief Review Complete	↑	
04-25-2007	Date Forwarded to Examiner	↑	

U.S. Serial No. 10/049,427
Group Art Unit 1617

03-01-2007	Defective / Incomplete Appeal Brief Filed		↑
03-01-2007	Appeal Brief Filed		↑
01-03-2007	Notice of Appeal Filed		↑
10-03-2006	Mail Non-Final Rejection		
09-29-2006	Non-Final Rejection		
08-28-2006	Information Disclosure Statement considered		
08-28-2006	Electronic Information Disclosure Statement		31
08-28-2006	Information Disclosure Statement (IDS) Filed		
07-28-2006	Information Disclosure Statement considered		↑
07-28-2006	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		↑
07-28-2006	Workflow - Request for RCE - Begin		↑
07-28-2006	Date Forwarded to Examiner		↑
07-28-2006	Date Forwarded to Examiner		↑
07-28-2006	Request for Continued Examination (RCE)		↑
07-28-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
07-28-2006	Request for Extension of Time - Granted		
07-28-2006	Information Disclosure Statement (IDS) Filed		
07-28-2006	Information Disclosure Statement (IDS) Filed		
07-21-2006	Miscellaneous Incoming Letter		
06-21-2006	Mail Examiner Interview Summary (PTOL - 413)		
06-08-2006	Examiner Interview Summary Record (PTOL - 413)		
04-04-2006	Notice of Appeal Filed		90
04-04-2006	Request for Extension of Time - Granted		↑
03-29-2006	Case Docketed to Examiner in GAU		↑
10-04-2005	Mail Final Rejection (PTOL - 326)		↑
09-19-2005	Final Rejection		
07-08-2005	Miscellaneous Incoming Letter		
07-08-2005	Information Disclosure Statement (IDS) Filed		
07-08-2005	Information Disclosure Statement (IDS) Filed		
07-20-2005	Date Forwarded to Examiner		
07-08-2005	Response after Non-Final Action		28
07-08-2005	Request for Extension of Time - Granted		↑
05-20-2005	Mail Miscellaneous Communication to Applicant		↑
05-19-2005	Miscellaneous Communication to Applicant - No Action Count		↑
05-20-2005	Mail Miscellaneous Communication to Applicant		↑
05-19-2005	Miscellaneous Communication to Applicant - No Action Count		↑
02-28-2005	Reference capture on IDS		↑

02-28-2005	Information Disclosure Statement (IDS) Filed		271
02-28-2005	Information Disclosure Statement (IDS) Filed		
03-10-2005	Mail Non-Final Rejection	159	
03-07-2005	Non-Final Rejection	↑	
01-27-2005	Case Docketed to Examiner in GAU	↑	
07-21-2004	IFW TSS Processing by Tech Center Complete	↑	
07-21-2004	Correspondence Address Change	↑	
07-21-2004	Change in Power of Attorney (May Include Associate POA)	↑	
06-02-2004	Information Disclosure Statement (IDS) Filed	↑	
06-02-2004	Information Disclosure Statement (IDS) Filed	↑	
06-02-2004	Oath or Declaration Filed (Including Supplemental)	↑	
07-21-2004	Date Forwarded to Examiner	↑	
06-02-2004	Response after Non-Final Action		91
06-02-2004	Request for Extension of Time - Granted	↑	
06-02-2004	Workflow incoming amendment IFW	↑	
12-03-2003	Mail Non-Final Rejection	↑	
12-01-2003	Non-Final Rejection		
09-17-2003	Date Forwarded to Examiner		
09-15-2003	Response to Election / Restriction Filed		
08-15-2003	Mail Restriction Requirement	40	
08-15-2003	Requirement for Restriction / Election	↑	
06-02-2003	Information Disclosure Statement (IDS) Filed	↑	
06-02-2003	Information Disclosure Statement (IDS) Filed	↑	
04-29-2003	Information Disclosure Statement (IDS) Filed	↑	
04-29-2003	Information Disclosure Statement (IDS) Filed	↑	
06-25-2002	Information Disclosure Statement (IDS) Filed	↑	
06-25-2002	Information Disclosure Statement (IDS) Filed	↑	
12-20-2002	Case Docketed to Examiner in GAU	↑	
06-13-2002	Application Dispatched from OIPE	↑	
06-11-2002	IFW Scan & PACR Auto Security Review	↑	
05-31-2002	Notice of DO/EO Acceptance Mailed	↑	
05-06-2002	Additional Application Filing Fees	↑	
05-06-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	↑	